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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/506,571

09/03/2004

Kazuyuki Yamane

2004-1232A

3093

513

7590

04/04/2008

WENDEROTH, LIND & PONACK, L.L.P.

2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

THAKUR, VIREN A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/506,571	<b>Applicant(s)</b> YAMANE ET AL.	
	<b>Examiner</b> VIREN THAKUR	<b>Art Unit</b> 1794	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 19 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): The objection to claim 40 has been withdrawn.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 25-29,31-33,41 and 42.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/Steve Weinstein/  
 Primary Examiner, Art Unit 1794

Continuation of 11. does NOT place the application in condition for allowance because:

In response to applicant's argument that none of the above mentioned references disclose or suggest the effectiveness of the addition of an inorganic electrolyte for suppressing the penetration of hot water through a hydrophobic resin layer to prevent opalescence of an inner glycolic acid copolymer layer, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). As stated in the prior Office action, mailed December 19, 2007, it is noted that Etsuno reference provides motivation for adding an inorganic electrolyte such as sodium chloride into the water of a sterilization process.

On page 8 of the response, applicants assert that the Examiner's assumption ignores a strong prejudice to the boiling or retort hot water treatment of a packaging material including a polyglycolic acid layer. This argument has been considered but is not deemed persuasive, since Shiiki et al. teach "burying" the polyglycolic acid polymer film between polyamide films. Shiiki et al. also provide motivation for using polyglycolic acid films in place of ethylene vinyl alcohol for improved high temperature and high humidity processing conditions (See Column 2, lines 16-28).

Applicants further assert that the since the moisture sensitivity of polyglycolic acid is much more severe than ethylene vinyl alcohol because of its hydrolyzability. Applicants therefore assert that polyglycolic acid layers when directly exposed to boiling water containing no inorganic electrolytes are readily hydrolyzed. It is respectfully noted by the examiner, however, that Shiiki et al. teach using the polyglycolic acid in combination with polyamides, wherein the polyglycolic acid film layer is buried between polyamide films.

Further on page 8, Applicants assert that Etsuno discloses adding sodium chloride for the purpose of elevating the boiling temperature, which thus results in a modification for promoting the hydrolyzability of polyglycolic acid. It is not clear as to where in Etsuno, this is taught. It is further unclear as to where in Etsuno, a polyglycolic acid film is disclosed. Furthermore, it is unclear as to how the addition of sodium chloride to retort water would result in promoting the hydrolyzability of a polyglycolic acid film in the combination of the prior art but Applicants are successful in preventing this same hydrolyzability. Additionally, it is noted, as discussed above, that Shiiki et al. teach that the gas barrier film is not in direct contact with the water. Since such films are readily hydrophilic, direct contact with the water would destroy the films appreciable properties, such as the high gas barrier properties.